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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXEI BORISOVICH BOGATYREV

Appeal 2009-002185
Application 10/537,274
Technology Center 3700

Decided:¹ June 12, 2009

Before: WILLIAM F. PATE, III, LINDA E. HORNER and
FRED A. SILVERBERG, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 2-11. We have jurisdiction under 35 U.S.C. § 6(b). The claims are directed to a device for handling stacks of bank notes. Claim 3, reproduced below, is illustrative of the claimed subject matter:

3. A device for banding stacks of bank notes comprising:
 - a body;
 - a container for packing material having a box-like structure;
 - a means for feeding said packing material;
 - and,
 - an element for arranging said stacks of bank notes.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hoffman	US 3,186,333	Jun. 1, 1965
Swaithes	US 3,448,557	Jun. 10, 1969

Claims 3-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hoffman. Ans. 3.

Claims 2², 3 and 5-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Swaithes. Ans. 5.

ISSUES

Appellant separately argues the rejections of claim 3 as being anticipated by both Hoffman and Swaithes. Appellant provides separate remarks regarding the rejection of claim 4. Appellant's remarks regarding the rejections of claims 5-11 are based solely upon the propriety of the rejections of claim 3.

Regarding the rejection of claims 3 and 4 as being anticipated by Hoffman, the issues presented are:

Has the Appellant established that the Examiner erred by rejecting claim 3 as anticipated by Hoffman because the claimed "element for arranging" cannot reasonably be interpreted to include the guide tube 36 of Hoffman? App. Br. 6.

Has the Appellant established that the Examiner erred by rejecting claim 3 as anticipated by Hoffman because the claimed container cannot reasonably be interpreted to include the chute 38 of Hoffman, since Hoffman's chute is not a box-like container? App. Br. 6-7.

Has the Appellant established that the Examiner erred by rejecting claim 4 as anticipated by Hoffman because the claimed packing material, stacked in a flattened condition, cannot reasonably be interpreted to include the tube of rubber bands 12? App. Br. 7.

It is noted that Appellant alleges that Hoffman teaches away from the subject matter of claim 3. App. Br. 7. Since teaching away is irrelevant to

² The Examiner's correction to claim 2 in the claims appendix to depend from claim 3 and accurately reflect the record is noted.

anticipation, this argument is not addressed further with respect to the rejection of claim 3 as anticipated by Hoffman. *See Seachange Int'l, Inc. v. C-COR, Inc.* 413 F.3d 1361, 1380 (Fed. Cir. 2005).

Regarding the rejection of claim 3 as being anticipated by Swaithes, the issue presented is:

Has the Appellant established that the Examiner erred by rejecting claim 3 as anticipated by Swaithes because the claimed “element for arranging” cannot reasonably be interpreted to include the bag transporting fingers 76 of Swaithes, because those fingers are designed to feed packing material as opposed to the article that is packed? App. Br. 8.

It is noted that Appellant argues that Swaithes does not anticipate claim 3 because it is from an entirely different field of endeavor. Whether a reference is analogous art, however, is irrelevant to whether that reference anticipates a claim. A reference may be from an entirely different field of endeavor than that of the claimed invention, or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses each and every limitation recited in the claim. *State Contracting & Eng'g Corp. v. Condotte Am., Inc.*, 346 F.3d 1057, 1068 (Fed. Cir. 2003) (citations omitted). Accordingly, this argument is not addressed further.

FINDINGS OF FACT

1. Hoffmann discloses a machine for snapping a rubber band or other type of resilient band 11 around an article 10 such as, for example, a newspaper, wrapped commodity, or the like. Col. 4, ll. 1-15.

2. Hoffmann's machine has a housing 30 (read by the Examiner as the claimed "body"), with an opening having a guide tube 36 for receiving the articles to be encircled by the bands (read by the Examiner as the claimed "element for arranging [the] stacks of bank notes"), and a feed chute 38, having a generally oval cross section and slightly curved portion (read by the Examiner as the claimed "container for packing material having a box-like structure") for storing and supporting tubes of rubber bands 12 (read by the Examiner as the claimed "packing material stacked in a flattened condition") in a position where they can be fed to the expander fingers 14-17 (read by the Examiner as the claimed "means for feeding said packing material"). Col. 5, ll. 49-60.
3. Swaithes discloses a machine for packing garments 180 in a bag or envelope 41. Col. 1, ll. 25-29.
4. Swaithes' machine has a table 20 (read by the Examiner as the claimed "body"), the top 21 of which has a well 40 (read by the Examiner as the claimed "container for packing material having a box-like structure"), for supplying bags 41 (read by the Examiner as the claimed "packing material") (col. 3, ll. 16-18), which are picked up by arm 130 (read by the Examiner as the claimed "means for feeding [the] packing material") (col. 6, ll. 17-28) and fed to bag-transporting fingers 76 (read by the Examiner as the claimed "an element for arranging [the] stacks of bank notes"), which transport the bag around the garment on board 30 (col. 7, ll. 30-56).

PRINCIPLES OF LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). These elements must be arranged as in the claim under review but this is not an *ipsissimis verbis* test. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

The PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997). Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 415 F.2d 1393, 1404-05, (CCPA 1969). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is "necessary to give life, meaning, and vitality" to the claim, then the claim preamble should be construed as if in the balance of the claim.

Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed. Cir. 1999). If the body of a claim fully and intrinsically sets forth all of the

limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Id*

A patent applicant is free to recite features of an apparatus either structurally or functionally. *See In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, i.e., by what it does, carries with it a risk. *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*:

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

439 F.2d at 213.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *See, e.g., In re Schreiber*, 128 F.3d at 1477-78. Thus, the mere recitation of the material or article intended to be worked upon by the apparatus being claimed does not impart patentability to the claims. *See e.g., In re Otto*, 312 F.2d 937, 940 (CCPA 1963); *In re Lampert*, 245 F.2d 253, 256 (CCPA 1957); *In re Rishoi*, 197 F.2d 342, 345 (CCPA 1952).

ANALYSIS

Although the Examiner initially opines that the article worked on, the “stacks of bank notes,” should not be afforded any patentable weight (Ans. 3), the Examiner has in fact given some consideration to this limitation, indicating that the Hoffman device would be fully capable of banding stacks of bank notes. Ans. 4. The Examiner does not regard this limitation as a means-plus-function limitation (Ans. 7, 12) and the Appellant has not contended that this limitation should be interpreted as a means-plus-function limitation. The Appellant describes the structure that is defined by this limitation “[i]n the specific embodiment” but does not indicate an intent to limit this limitation to that specific structure. Ans. 3; *See also* 37 CFR 41.37(c)(1)(v) (requiring the identification of means-plus-function limitations in the Appeal Brief). Accordingly, the stacks of bank notes are regarded only as the article that the claimed machine is intended to operate upon. They do not form part of the claimed device or imply the presence of any specific structure.

Hoffman acknowledges that his device is not only intended to band newspapers but is fully capable of banding other articles. Fact 1. The Examiner reasonably concludes that Hoffman would be inherently capable of performing the recited intended use of banding stacks of bank notes, and that the guide tube of Hoffman, read as the claimed “element for arranging,” would inherently be capable of arranging bank notes by directing them to a position wherein they can be bound. Since Appellant has not established that Hoffman lacks such capability (App. Br. 6), Hoffman’s guide tube is reasonably read as the claimed “element for arranging [the] stacks of bank notes.”

The Examiner opines that the feed chute 38 is a “container having a box-like structure” because a finding that an element is a chute does not preclude a finding that that element is also a container and the term “box-like structure” does not necessarily exclude vertical containers having ovular cross sections and slight curvature. Ans. 10-11; App. Br 6-7. In addition to storing and containing the bands, the chute 38 also allows them to intermittently advance downwardly. This additional capability does not destroy the ability of the chute to contain the bands by surrounding them. Since the chute 38 stores and contains the bands within it, it is reasonably read as the claimed container. App. Br. 7. Regarding the term “box-like structure” the Examiner is essentially interpreting the term “box” to mean some form of receptacle that could take on a variety of shapes including curved or ovular shapes commonly associated with jewelry boxes or hat boxes, for example. The Appellant, on the other hand, is interpreting the term “box” to imply a specific geometric shape—rectangular, and therefore “box-like” as excluding curved structures. Both the Examiner’s and the Appellant’s interpretations are common and acceptable interpretations of the term “box.” Although the container 2 has a rectangular profile when viewed from the front or right side in figures 1 and 2, respectively, the Specification does not expressly define the term “box” to require a rectangular structure, nor does it define the term “box-like” to exclude containers having curves. Furthermore, there no indication that that the container 2 described in the Specification is itself rectangular, and not curved or ovular, for example, when viewed from the top.

Additionally, even if the term “box” were interpreted to require a rectangular geometry as Appellant suggests, the term “-like” indicates that

there is some degree of latitude that the container may have deviating from that geometry and there is no reason to limit that latitude to exclude structures having curved portions or cross sections. It is well-settled that during examination claim terms are given their broadest reasonable interpretation in light of the Specification. It would be improper to impose limitations on claim terms that are not explicitly recited in the claims or required in light of the Specification. Although broader than the interpretation that Appellant suggests, the Examiner's interpretation of "box-like" is reasonable in light of the Specification.

Appellant contends that since the rubber bands of Hoffman are initially supplied in a tubular form they are not "in a flattened condition" as required by claim 4. While the Specification indicates that the ring 3 is converted from its flattened condition to an unfolded state (p. 8, ll. 17-19; fig. 5), there is no further detail in the Specification to define or describe what constitutes a "flattened condition." All that can be deduced from the Specification is that, in the flattened condition, the top and bottom of the band are substantially closer together than they are in figure 5. There is no indication that "a flattened condition" requires the top of the band and the bottom of the band to be in contact with each other. Hoffman's bands are substantially planar and therefore in a "flattened condition" in the tube state depicted in figure 2. In this condition they are "flattened" as compared to the expanded condition depicted in figures 1 and 5-7.

Additionally, the phrase "flattened condition" in claim 4 further limits the packing material recited in parent claim 3. Claim 3 requires "a container for packing material" and "a means for feeding [the] packing material." Even if Appellant's interpretation of the term "flattened condition" were

adopted, in order to meet the limitations of claim 4, Hoffman must only disclose a container for storing the packing material in a flattened condition and structure for feeding the packing material that is the same as the disclosed structure or a section 112, paragraph 6 equivalent. Appellant has not proffered any reason why Hoffman's chute, read as the claimed container, would be incapable of storing the packing material if the top and the bottom of the band were in contact, and we can find none. Nor has Appellant disputed the Examiner's finding that Hoffman's expander fingers 14-17 are a section 112, paragraph 6 equivalent to the claimed "means for feeding [the] packing material." Ans. 7, 12. Appellant has not established that changing the function to "feeding the packing material stacked in a flattened condition" would destroy the Examiner's conclusion that Hoffman's expander fingers 14-17 are a section 112, paragraph 6 equivalent to the claimed means. There is no indication that they would function any differently if the packing material were stacked with the top and the bottom of the band in contact. For these reasons, Hoffman discloses each and every element of claims 3 and 4 (Fact 2), and Appellant has failed to establish that the Examiner erred by rejecting claims 3 and 4 under 35 USC § 102(b) as being anticipated by Hoffman.

Regarding the Swaithes reference, while we agree with Appellant that bag transporting fingers 76 are used to feed the packing material, that does not preclude those fingers from being an "element for arranging [the] stacks of bank notes." Appellant has not supported his position with any rationale regarding why packing an article does not constitute arranging it. Again, both the stacks of bank notes and the packing material are recited as articles that the machine is intended to operate upon. The fact that the claimed

invention is intended to operate upon different articles than Swaithes (*see Fact 3*) does not patentably distinguish the claimed invention from Swaithes. The phrase “element for arranging [the] stacks of bank notes” only requires some structure that can contribute to the arranging of stacks of bank notes if that is the article operated upon by the Swaithes machine. If bank notes are the article worked upon in place of the garment, board 30, is an “element for arranging” because the stack of bank notes would be arranged on board 30 prior to being packed.

In the alternative, however, fingers 76 are also an “element for arranging” because they would function to arrange the stacks of bank notes within the packing material. Both board 30 and fingers 76 cooperate to arrange the article in the packing material. Given the breadth of the limitation, both board 30 and fingers 76 are reasonably read as an “element for arranging” within the broadest reasonable interpretation of that term. Appellant has not established that either of these elements would be incapable of arranging bank notes or suggested any alternative interpretation of the term “arranging.”

For these reasons, Swaithes discloses each and every element of claim 3 (Fact 4) and Appellant has failed to establish that the Examiner erred by rejecting claim 3 under 35 USC § 102(b) as being anticipated by Swaithes.

CONCLUSION OF LAW

On the record before us, Appellant has failed to establish that the Examiner erred by rejecting claims 3-9 under 35 U.S.C. § 102(b) as being anticipated by Hoffman or claims 2, 3 and 5-11 under 35 U.S.C. § 102(b) as being anticipated by Swaithes.

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DECISION

For the above reasons, the Examiner's rejections of claims 2-11 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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